

REMARKS

Claims 66-84 are pending in the application. By this paper, claims 66, 68, 77 and 79 have been amended. Reconsideration and allowance of claims 66-84 are respectfully requested.

Objections to the Specification

Claim to priority

The specification stands objected to based on the claim to priority of earlier-filed applications. According to the office action, "the attempt to claim priority by reference to application to serial no. 09/911,674 filed July 24, 2001 and application serial no. 09/322,677 filed on May 28, 1999 is improper because the above applications do not support the limitations of the newly revised claims.

Withdrawal of this objection is respectfully requested. It is submitted that the claim for priority included at page 1 of the present application states that "this application is a continuation in part" of the noted applications. "A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, repeating some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the said earlier nonprovisional application." MPEP 201.08. Support for the limitations of the claims of this application is found throughout the application, including in material of the parent applications and in the added matter not disclosed in the earlier applications. Moreover, "an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier non-provisional application if the alleged continuation-in-part application complies with the following formal requirements of 35 U.S.C. § 120:

"(A) The first application and the alleged continuation-in-part application were filed with at least one common inventor;

"(B) The alleged continuation-in-part application was 'filed before the patenting or abandonment of ...the first application or an application similarly entitled to the benefit of the filing date of the first application'; and

“(C) The alleged continuation-in-part application ‘contains ... a specific reference to the earlier filed application.’”

Each of these requirements is fulfilled in the present application. With respect to requirement (A), inventor Darren J. Davis is common to the present application and the two parent applications. With respect to requirement (B), the present application was filed on December 11, 2001 and the immediate parent application, serial number 09/911,674, is still pending as of November 21, 2005. With respect to requirement (C), the application was filed with the required reference beginning at page 1, line 4. Accordingly, it is submitted that the claim for priority is properly made. Withdrawal of the objection to the specification and acknowledgement of the claim to priority is respectfully requested.

Embedded Hyperlinks

The disclosure is further objected to as containing an embedded hyperlink in paragraphs 6, 8, and 99. Deletion of the embedded hyperlink is required.

By this paper, the specification has been amended at several places to delete the embedded hyperlinks. No new matter is added by these amendments. Withdrawal of the objection to the disclosure is respectfully requested.

Claim Objections

Claims 68, 70 and 77 stand objected to under 37 C.F.R. § 1.75(c) as being of independent form. Claim 68 recites “determining a quality metric for each candidate search term.” According to the office action, “each candidate search term” does not further limit any elements of claim 66.

Claim 68 has been amended so that it now recites “determining a quality metric for each potential search term” (*emphasis added*), referring back to the potential search terms recited in claims 66 and 67. It is submitted that as amended, claim 68 properly limits claim 66 and withdrawal of the objection to claim 68 is respectfully requested.

Claim 70 stands “objected to for being dependent from a rejected claim.” For reasons stated elsewhere in this paper, it is submitted that claim 68 is allowable. Withdrawal of the objection to claim 70 is respectfully requested.

Claim 77 also stand objected to. According to the office action, “claim 77 recites ‘determining a quality metric for candidate search terms; and predicting relevance of candidate search terms based on the quality metric.’” Further according to the office action, “Candidate search term does not further limit any elements of claim 76.”

Claim 77 has been amended so that it now recites “... potential search terms...” (*emphasis added*) in place of the reference to “candidate search terms”. It is submitted that as amended, claim 77 properly limits claim 66 and withdrawal of the objection to claim 77 is respectfully requested.

Claim rejections under 35 U.S.C. § 112

Claims 66-84 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the office action, the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention.

According to the office action, claim 66 recites “obtaining a set of potential search terms,” which was not clearly and concisely contained in the specification. However, the published patent application no 2003/0055816 at paragraph [00107], beginning at page 37, line 19 of the application as filed, recites

The technique gets its initial list of accepted terms in one of three ways: either directly from the advertiser, or from an existing advertiser’s bid list, or from the list of recommendations returned by running the web spider on the new advertiser’s web site.

In claim 66, the terminology “potential search term” is used to emphasize that the search term is to be provided or offered to the information provider for acceptance as a search term to be associated with him and stored in the database—it is at this point just a *potential* search term of the advertiser. It is respectfully submitted that this clearly shows how the claimed method may “obtain[] a set of potential search terms.”

Further according to the office action, claim 66 recites “other information providers,” which is considered to be absent from the specification. However, as noted above, the published patent application no 2003/0055816 at paragraph [00107], beginning at page 37, line 19 of the

application as filed, recites “[t]he technique gets its initial list of accepted terms in one of three ways: either directly from the advertiser, or from an existing advertiser’s bid list...” (*emphasis added*). This is illustrated at, for example, block 1012 of FIG. 10 of the application as filed. As used in the present application, “information provider” is generally synonymous with “advertiser,” as explained a paragraph [0039], the paragraph beginning at page 10, line 24, of the application as filed.

Further according to the office action, claim 66 recites “a new information provider,” which is considered unsupported in the specification as filed. However, the published patent application no 2003/0055816 at paragraph [00108], beginning at page 38, line 4 of the application as filed, recites

In typical use, a new advertiser will start with the URL of his web site and go through 3-5 iterations of accepting and rejecting terms. As long as his web site is similar to those of existing advertisers, the system will quickly identify them and make high quality recommendations.

As noted above, as used in the present application, “information provider” is generally synonymous with “advertiser,” as explained a paragraph [0039]. The invention defined by claim 66 recites “obtaining a set of potential search terms for acceptance by a new information provider who is adding items to the database.” Thus, in the context of claim 66, it is presumed that there are *preexisting advertisers* or information providers who already have search terms stored on the database. Claim 66 relates to adding a new advertiser and his associated search terms to the database.

Further according to the office action, claim 66 recites “receiving from the new information provider at an input device an indication of accepted search terms,” which is considered unsupported in the specification as filed. However, published patent application no 2003/0055816 at paragraph [00112], beginning at page 39, line 12 of the application as filed, recites

The advertiser accepts and rejects terms by clicking on suitable check boxes next to the terms. When he is done making his changes, he clicks a button to transmit the page of data to the server and rerun the collaborative filtering algorithm. The advertiser can continue through as many iterations as he likes, repeating the loop, block 1014, until he is satisfied with the terms he has accepted. He then clicks a final button to exit the loop, block 1020, and store or print out his selected search terms. (*emphasis added*)

It is respectfully submitted that this clearly shows how the claimed method may “receiv[e] from the new information provider at an input device an indication of accepted search terms.”

Further according to the office action, claim 66 recites “repeating (b) through (e) until a completion indication is received from the new information provider,” which is considered unsupported in the specification as filed. However, published patent application no 2003/0055816 at paragraph [00112], beginning at page 39, line 20 of the application as filed, recites

The advertiser can continue through as many iterations as he likes, repeating the loop, block 1014, until he is satisfied with the terms he has accepted. He then clicks a final button to exit the loop, block 1020, and store or print out his selected search terms.
(emphasis added)

It is respectfully submitted that this clearly shows how the claimed method may “repeat[e] (b) through (e) until a completion indication is received from the new information provider.”

Further according to the office action, claim 66 recites “sorting the potential search terms according to the computed estimated rating,” which is alleged to lack support in the specification as filed. However, published patent application no 2003/0055816 at paragraphs [00104] – [0105], beginning at page 35, line 19 through page 37, line 8 of the application as filed, recites

Quantitatively, collaborative filtering computes the Pearson correlation between the new advertiser and all of the existing advertisers. To calculate this correlation, a numeric rating is assigned to each entry in the advertiser/term table.... The output of the collaborative filter is the list of search terms sorted by their estimated ratings.

Further, at paragraphs [00118], beginning at page 35, line 19 through page 37, line 8, the application as filed recites

After processing all search terms, the loop is exited at block 1210. At the end of the algorithm terms are sorted by their predicted ratings, block 1212. The method returns the final list as its ranked list of recommendations and then ends at block 1214.

It is respectfully submitted that this clearly shows how the claimed method may “sort[] the potential search terms according to the computed estimated ratings.”

According to the office action, claim 79 stands rejected on a similar basis as claim 66. Independent claim 79 recites a computer network search engine apparatus. It is submitted that

support for limitations of claim 79 is found throughout the application as filed, including at the locations noted above for the limitations of claim 66. Withdrawal of the rejection to the claims under 35 U.S.C. § 112 is respectfully requested.

Prior art rejections

Claims 66, 71, 75, 76, 78, 79, 83 and 84 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent number 6,314,420 to Lang, et al. ("Lang"). Claims 67 72-74 and 80-82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lang in view of U.S. patent no. 6,078,916 to Culliss ("Culliss").

The present invention defined by claims 66-83 relates to a method and apparatus for making search term recommendations to an information provider in a computer network search apparatus. In the particular network search apparatus of claim 66, items stored in a database "hav[e] associated with [them] at least one search term, an information provider and a bid amount," as recited in the preamble of claim 66. Thus, there is an association between the items or search listings and the information provider. The present invention defined by claims 66-83 provides a method and apparatus for recommending search terms to a new information provider, i.e., one who has not previously stored search terms on the database or associated search terms with himself. Because the advertiser or information provider may not know what search terms to specify, or may wish to have a broader range of search terms than he can think up spontaneously, the advertiser may seek recommendations of other search terms. The claimed method and apparatus make search term recommendations based on the contents of the information provider's own web site and by comparing the advertiser to other similar information providers and recommending search terms they have chosen.

The method acts of claim 66 define how search terms are recommended to one such information provider, particularly a "new information provider" who is establishing search listings on the computer network search apparatus. Generally, according to the method, a set of potential search terms is obtained, computations are done including an estimated rating for each potential new search term, the potential search terms are sorted and presented to the new information provider who provides an indication of which are accepted search terms. Claim 66 has been amended to clarify that, upon receipt of the indication, the search terms which have

been accepted by the new information provider are stored. Thus, the claimed method provides an way in which a new information provider can establish search listings in a search system database by making suggestions of possible search terms to the advertiser.

In contrast, Lang actually relates to a search engine system which employs a content-based filtering system for receiving informons from a network on a continuing basis and for filtering the informons for relevancy to a wire or demand query from a user (Summary). Lang fails to disclose “a method for recommending search terms” to an information provider who is associated with items such as search terms stored in the database. Lang is related to a search engine system, but it is not of the type in which stored items are “associated with at least one search term, an information provider and a bid amount.” These are features of a *pay for placement* database search system and are nowhere shown, described or suggested by Lang.

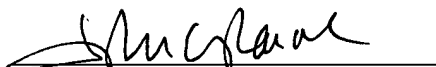
Culliss does not provide the missing teaching. As noted in the Amendment filed July 13, 2005, the Culliss reference discloses a search system including banner advertisements which is quite different from the presently claimed system. Culliss discloses a system in which search activity of a user is monitored and used to organize articles displayed in search results (Summary, pages 2-3). As users enter search queries and select articles, the scores of the articles are altered and then used in subsequent searches to organize articles matching a search query. Culliss thus fails to disclose a search system in which items in a database are associated with an advertiser or information provider--a pay for placement market system

Claim 79 has been amended along with claim 66, to distinguish the cited references. No new matter is added by this amendment, which finds support throughout the application and particularly at page 39, lines 12-26, paragraph [0112] of U.S. patent publication number 2003/0055816. Thus, independent claims 66 and 79 each recite limitations nowhere shown, described or in any way suggested by Lang. Accordingly, each of these independent claims is patentable over this reference. Claims 67-78 and 68-84 are dependent from claims 66 and 79, respectively, and each is therefore allowable for the same reasons. Accordingly, reconsideration and allowance of claims 66-84 are respectfully requested.

Application no. 10/020,712
Amendment dated: November 21, 2005
Reply to office action dated: August 24, 2005

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,


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